

Applicants: Augustijn et al.
Serial No. 09/843,915
Page 2

REMARKS

With all due respect, Applicant must assert that the pending claims have not received a proper examination based upon the laws, regulations, and rules of practice applicable to the United States Patent and Trademark Office. As such, Applicant must request withdrawal of the finality of the above noted Office Action and the issuance of an appropriate subsequent action.

In response to the Office Action mailed September 5, 2003 Applicant pointed out a series of problems with the rejections contained therein. While the Examiner is free to disagree with the conclusions drawn, these issues must be considered and addressed on the record by the Examiner. The above referenced Final Office Action simply a) repeats verbatim the earlier rejections; b) inappropriately identifies a "key concept"; c) asserts without support that the claims are too broad; and d) makes a conclusory statement that hindsight was not the basis of one of the rejections.

The Examiner has not addressed on the merits a single one of the serious issues previously raised in the earlier response. Furthermore, the statements of the Final Office Action indicate a misunderstanding of the relevant rules of practice.

I. Identification of a "Key Concept" is Wholly Improper

The Examiner should not have attempted to distill the presently claimed invention down to a "key concept". This is extremely inappropriate and provides direct evidence that the Examiner is not considering the claims as a whole, as explicitly required by the rules of practice. For the record, Applicant also disagrees with the Examiner's assessment of the claimed subject matter.

Whether or not Kitamura et al. teaches this "key concept" as defined by the Examiner is entirely irrelevant as the claims, when considered as a whole, patentably define over Kitamura et al. alone or in combination with DuLac et al. Applicant respectfully directs the Examiner to M.P.E.P. 2141.02.

Applicants: Augustijn et al.
Serial No. 09/843,915
Page 3

Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole."

M.P.E.P. 2141.02 (Emphasis Added). Thus, the Examiner's attempt to define a "key concept" and focus on that and that alone in comparison to the reference is wholly inappropriate and explicitly prohibited. Applicant respectfully requests acknowledgement of the same, retraction of the statements of paragraph 14 of the Final Office Action, and a substantive examination of the merits of the claims considered as a whole.

II. The Examiner's Assessment of Claim Breadth Is Irrelevant

In paragraph 14, the Examiner indicates that since "the independent claims are very broad and were not further amended/elaborated on the key concept . . . the Examiner retains the rejection."

~~Breadth is not a basis~~ for rejection and may not be relied upon as such by the Examiner. The Examiner has not evaluated the claims as a whole or provided a proper *prima facie* case of obviousness. As such, regardless of how broad the Examiner believes the claims, they patentably distinguish over the prior art of record and are allowable. Should the Examiner wish to make such statements in subsequent actions, Applicant requests explicit legal authority for doing so, that further indicates the relevance and applicability of using the Examiner's subjective assessment of breadth as a basis for a rejection.

Since the Examiner has not provided a proper *prima facie* case of obviousness, the rejection must be withdrawn. Simply asserting that despite the

Applicants: Augustijn et al.
Serial No. 09/843,915
Page 4

lack of such a case, the Examiner's opinion is that the claims are "very broad" and maintaining the rejection because Applicant has not amended the claims is also wholly inappropriate and without support in the rules of practice.

III. Hindsight

In Applicant's earlier response it was pointed out that the Examiner's proposed combination with respect to Claims 23, 25, 26 and 31 made little sense. For example, claim 31 includes a converter for converting the sensed data. The Examiner suggests it would be obvious to add such converter to the Kitamura et al. device "because that would reduce the time necessary to carrying out the data transfer." This line of reasoning is fundamentally flawed for a number of reasons. The Examiner's only rebuttal was to indicate the portion of the Kitamura et al. reference that states that it was an object to "provide a buffer storage system wherein the time necessary . . . can be reduced."

First, the addition of an otherwise unnecessary converter would *increase* the processing time, not decrease that time. There is no data to convert, so the addition of such a converter is useless. As such, the only reason to make such a combination is the Examiner's desire to forge a rejection.

Second, this line of reasoning is illustrative of the issue of not considering either the claims or the reference as a whole. The claimed invention relates to a medical device that senses and processes data. Kitamura is a buffering system that moves information, in the same form, from one memory area to another for accessibility. Applicant incorporates the remarks from the previous response, which address these issues in greater detail.

In summary, the Examiner appears to misunderstand either the basis required for presenting a *prima facie* case of obviousness or Applicant's contention that the Examiner's proposed modifications are a) not obvious; b) are logically inconsistent; and c) do not result in the claimed invention. The issue is not whether it would have been possible to modify Kitamura in a manner to make

Applicants: Augustijn et al.
Serial No. 09/843,915
Page 5

it operate faster, the issue is whether it would have been obvious to modify Kitamura into the claimed invention (as a whole).

The only way the Examiner's position can be rectified is if the claim language is essentially ignored, the plain meaning of the terms is ignored, the invention is distilled down to some ethereal "key concept" manufactured by the Examiner, and accept that the "modification" proposed has no basis in reality.

IV. Claim as a Whole

As previously pointed out by Applicant, the presently claimed invention is directed to a medical device, as for example, indicated in the preamble of claim 22. As this is more than an "intended use" and defines the structural environment under consideration, it must be taken into account. M.P.E.P. 2111.02. When considered as a whole, the Kitamura teaching bears little relevance to the claims. No medical device has been cited and this element has not been addressed in any Office Action.

Similarly, certain claims, e.g., claim 22, include a sensor for collecting data. In terms of a medical device, as claimed, such a sensor indicates leads, electrodes, pressure sensors, other physiologic sensors or the like that provide medically relevant data. The Examiner's assertion that the "buffer storage controller" is the claimed sensor is illogical, inconsistent with the language of the claims and specification, and cannot stand scrutiny. Despite previously pointing this issue out, the Examiner has not addressed or rebutted this issue. In summary, a "buffer storage controller" is not a sensor, as claimed.

In addition, when considered as a whole, the Examiner's combination and proposed modification becomes harder to understand. For example, Kitamura does not have a sensor; does not collect data; does not convert data; is not a medical device and does not operate in a manner similar to the presently claimed invention. The notion that a converter, for example, would be added to speed the process is illogical as the component is unnecessary and slows the process. The Examiner appears to be under the impression that the stated efficiency goal of

Applicants: Augustijn et al.
Serial No. 09/843,915
Page 6

the Kitamura reference is a license by which any component desired may be added by the Examiner while somehow providing a legal motivation to combine. Of course, this not the case.

V. Statutory Claims Not Properly Considered

1. Means plus function

Claims 43-42 are written in means plus function format under 35 U.S.C. 112, paragraph 6. In summary, the Examiner must construe the elements of the claims based upon the structure recited in the specification and any equivalents thereof. Specifically, when examining claims under 35 U.S.C. 112, paragraph 6 "the specification must be consulted to determine, the structure material or acts corresponding to the function recited in the claim." M.P.E.P. 2111.01. In addition, see M.P.E.P. 2181.

No such analysis under 35 U.S.C. 112, paragraph 6 has been performed. Rather, the Examiner asserts that these claims have "similar" limitations to method claims 1-17. Such a comparison is irrelevant and does not provide a basis of examination. The claimed structure must be analyzed in the context of the claims as a whole, in the manner addressed above.

This issue was also raised in the previous response and has not be addressed or rebutted.

2. Method claims

Similarly, various method claims were summarily rejected without substantive comment. For example, claims 1-3, 5, 7 and 8 were asserted to have "similar" limitations to claims 22-31 (apparatus claims). Again, the Examiner's subject assessment of similarity is not a ground of rejection. Method claims include steps or acts and apparatus claims include elements, thus it is difficult to comprehend how these claims are so similar as to preclude any discussion of a rejection. This is further complicated by the fact that the Examiner compares the means plus function claims to the method claims and the

Applicants: Augustijn et al.
Serial No. 09/843,915
Page 7

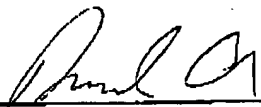
same method claims to the apparatus claims to arrive at a rejection. The claims must be individually assessed and evaluated.

VI. Conclusion

As the record clearly indicates, the claims have not been fully considered or examined. Applicant requests the withdrawal of the finality of the previous action and an Indication that the claims are allowable. Should the Examiner disagree, Applicant requests a full and complete Office Action that establishes proper grounds of rejection for properly interpreted claims.

Respectfully submitted,

Date: 5/3/04



Daniel G. Chapik
Attorney Reg. 43,424
Telephone: (763) 514-3066
Customer No. 27581